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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,367	07/29/2003	Richard Beeson	ITW 8108.64	6261
23721	7590	09/21/2004	EXAMINER	
CORRIGAN LAW OFFICE 5 BRIARCLIFF CT APPLETON, WI 54915			SHAW, CLIFFORD C	
			ART UNIT	PAPER NUMBER
			1725	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/629,367	Applicant(s) BEESON ET AL. CP	
	Examiner Clifford C Shaw	Art Unit 1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 8/9/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 40-59 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 and 40-46 is/are allowed.
- 6) ☒ Claim(s) 47-53 and 56-59 is/are rejected.
- 7) ☒ Claim(s) 54 and 55 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1.) Claim 54 is objected to because it depends from claim 43 (claim 54 is a method claim while claim 43 is an apparatus claim). This improper dependency is apparently the result of a typographical error. Claim 54 should depend from claim 53. For the purposes of this Office action, claim 54 will be assumed to depend from claim 53. Applicant is to correct this error in his response to this Office action.

2.) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.) Claims 47, 48, 50-53, 56, 58, and 59 are rejected under 35 U.S.C. 102(e) as being anticipated by Maekawa (5,703,410). The patent to Maekawa (5,703,410) discloses a method as claimed, including: generating an electrical output with engine 6 and generator 7; inverting the electrical output at 9; and controlling the engine at 14, 2, 3, 4 using a feedback signal from 8 that is “indicative” of the inverter output, since the inverter output depends on the nature of the input. In regard to claims 51-53 and 56, the feedback signal from 8 indicating the input into inverter 9 will necessarily be “indicative” of inverter current, voltage, or power.

Art Unit: 1725

4.) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.) Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maekawa (5,703,410). The only aspect of the claim to which the rejection above does not apply is the provision for rectifying the output of the inverter. This difference does not patentably distinguish over the prior art. At the time applicant's invention was made, it would have been obvious to have used the system of Maekawa (5,703,410) to power any conventional load, including a load that had a rectifier circuit (for example, any conventional electronic device that rectifies line power to provide dc for its internal operation), thereby satisfying the claim.

6.) Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maekawa (5,703,410) as applied to claims 47, 48, 50-53, 56, 58, and 59 above, and further in view of Gilardi (3,597,623, cited by applicant). The only aspect of the claim to which the rejection above does not apply is the provision for selecting between idle speed and run speed. This difference does not patentably distinguish over the prior art. It would have been obvious to have provided the system of Maekawa (5,703,410) with idle/run-speed selection as claimed, the motivation being the teachings of Gilardi (3,597,623) that the same is advantageous (see the abstract of Gilardi (3,597,623)), thereby satisfying the claim.

Art Unit: 1725

7.) Claims 54 and 55 are objected to for depending from rejected claims, but would be given favorable consideration if recast in independent form to include all of the limitations of the parent claims. The prior art of record does not teach or suggest the particular feed-back signal of claim 54 or the particular energy threshold based control of claim 55. Note that claim 54 is assumed to depend from claim 53.

8.) Claims 1-19 and 40-46 are allowable over the prior art of record. None of the prior art of record teaches or suggests a power supply with the control features of claims 1 and 14 whereby an inverter output is provided to a feedback circuit which in turn is coupled to a controller that is coupled to a primary mover as set forth in the claims. Note that in Maekawa (5,703,410), the feedback control of the primary mover is provided by a signal at the input of an inverter. The other claims are allowable at least because they depend from allowed claims 1 and 14. While this input signal is "indicative" of output (hence the rejections above), it is not the same as a signal based on the output of the inverter.

9.) Applicant's arguments filed 8/9/2004 have been fully considered but they are not persuasive. Claims 49-53 and 56-59 are unpatentable for the reasons set forth above.

10.) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1725

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Clifford C Shaw at telephone number 571-272-1182. The examiner can normally be reached on Monday through Friday of the first week of the pay period and on Tuesday through Friday of the second week of the pay period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas G. Dunn, can be reached at 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Application/Control Number: 10/629,367

Page 6

Art Unit: 1725

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Clifford C Shaw
Primary Examiner
Art Unit 1725

September 17, 2004